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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* THANE M. LARSON and KIRK BRESNIKER

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Appeal 2007-2433  
Application 09/924,029<sup>1</sup>  
Technology Center 2100

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Decided: March 14, 2008

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*Before* JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and JAY P.  
LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application filed August 7, 2001. The real party in interest is Hewlett-Packard family of companies.

## STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1 to 20 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a system, method and device (system) for providing network address information in a cPCI (Compact Peripheral Component Interconnect) server system for configuration of a plurality of host processor cards in a single rack mounted chassis. In the words of the Appellants:

In contrast to the prior art technique of providing an RS-232 connection to each individual server to set IP address information, the use of an IPMI<sup>2</sup>C bus 554 allows for multiple devices on one bus, thus greatly reducing the complexity of the system. This also allows for better remote management, since it is undesirable to have multiple connections into a server, or having to physically be present at the server to change configurations.  
(Spec. 17.)

Claim 1 is exemplary:

1. A server system comprising:

a plurality of host processor cards;

a management card coupled to the plurality of host processor cards via at least one bus, the management card including at least one user interface for receiving network address information from a user, the management card configured to send received network address information to the plurality of

host processor cards via the at least one bus, thereby configuring the host processor cards for management LAN communications.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Liu	US 6,185,110 B1	Feb. 6, 2001 (filed Jan. 29, 1999)
Sides	US 6,363,449 B1	Mar. 26, 2002 (filed Mar. 29, 1999)
Verthein	US 6,678,284 B1	Jan. 13, 2004 (filed Apr. 25, 2001)

The Examiner has entered a new rejection of claims 1 to 7 and a new rejection of claims 8, 14, and 20 in the Examiner's Answer, adding another reference (Sides) to the previously used Verthein, Admitted Prior Art (APA), and, with respect to the latter set of claims, Liu references (Ans., 2). We will take these rejections to be substitutes for the previous rejections of the same claims without the Sides references. The Examiner also states that the same rationale for the rejection of claim sets 9 to 13 and 15 to 19 applies as used for the rejection of claims 1 to 6. (Ans., 5). We thus assume that the new rejection, using the Sides reference, applies to those claims sets, 9 to 13 and 15 to 19 as well.

In summary, we take the following to be the current rejections:

R1: Claims 1 to 7, 9 to 13, and 15 to 19 stand rejected under 35 U.S.C. § 103(a) for being obvious over APA in view of Verthein and Sides.

R2: Claims 8, 14, and 20 stand rejected under 35 U.S.C. § 103(a) for being obvious over APA in view of Verthein, Sides and Liu.

Appellants contend that the claimed subject matter is not rendered obvious by Verthein alone, or in combination with Sides or Liu or APA, for failure of the references to teach or suggest claimed limitations, as will be discussed more fully below. The Examiner contends that each of the claims is properly rejected.

We reverse the rejections.

#### ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether the admitted prior art (APA) in view of the Verthein and Sides references teach all of the claimed limitations.

#### FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a server system in which the server contains a plurality of host processor cards plus a special card that manages the configuration of the processor cards so they can communicate across a local area network (LAN). (Spec. 1, l. 10+). The APA uses a serial RS232 port on each board to configure each of the host processor cards

with its IP (Internet Protocol) address. (Spec., 1, l. 16). By using the special management card to configure the host processor cards, the Appellants avoid the difficulty of running RS-232 lines to each board, and gains advantages when swapping host processor cards among servers and LANs. (Spec., 17, ll. 10 to 22).

2. Verthein teaches a communications access device, for example one used in public switched telephone networks, which acts as a communications server chassis. (Col. 1, l. 53). The chassis contains various cards such as modems for performing signal conversion for incoming and outgoing data. (Col. 3, l. 35). In addition to those standard cards, the chassis contains a special EdgeServer™ card which has located on it the hardware and software components of a general purpose computer, including interfaces for a video monitor, keyboard, and mouse. (Col. 4, l. 34). The EdgeServer card allows various programs, including management functions, to be run locally on the device and avoids having to rely on external computing power to perform those functions. (Col. 3, top paragraph).

#### PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie

obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. ... On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” [citations removed] *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The determination of whether an intended use clause is a limitation in a claim depends on the specific facts of the case. *In Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005), the court held that when a “whereby clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381 (Fed. Cir. 2003)) that “a whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.” *Id.*

“The term ‘prior art’ as used in section 103 refers at least to the statutory material named in 35 U.S.C. § 102. . . . However, section 102 is not the only source of section 103 prior art. Valid prior art may be created by the admissions of the parties.” *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354 (Fed. Cir. 2003) (citations omitted).

## ANALYSIS

Appellants contend that the Examiner erred in rejecting claim 1 because Verthein contains no teaching or suggestion that the computing card 24 includes at least one user interface for receiving network address information from a user. (Br., 6, middle). Nor, it is contended, is there a teaching in Verthein that the computing card 24 is configured to send received network address information to a plurality of host processor cards via a bus thereby configuring the host processor cards for management LAN communications.

On consideration, we find that the Appellants have a point. The APA teaches only the multiple host processor cards in a server, with individual RS-232 connections for receiving the configuration commands. (FF1, above) Verthein does teach having a computing card in a server box, and broadly teaches using that card for management duties. We can even find in Verthein the user interface for, potentially, receiving data from a user. (FF2). However, the Appellants have argued the representative claim 1 clearly requires that the management card is configured to send the network address information to the host processor cards, and thereby configuring the host processor cards for management LAN configuration. (Br. 6, middle). The Examiner has equated providing standard management functions within the chassis as this limitation. (Ans., 7 top). We find that the Verthein reference lacks sufficient specificity to support the rejection, as none of the claimed configuration is extant.



The Sides reference, which was cited for its teaching of the claimed bus structure, was not mentioned in the Examiner's rejection of claim 1 (Ans., 4) and does not supply the teachings that are lacking in Verthein.

Claims 8, 14, and 20 were rejected for being obvious over APA, Verthein, Sides, and Liu. Liu was added to the rejection for its teaching of the Liquid Crystal Display panel. As Liu does not supply the deficiencies in the APA and Verthein references, this rejection likewise cannot be supported.

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 1 to 7, 9 to 13, and 15 to 19 under 35 U.S.C. § 103(a) for being obvious over APA in view of Verthein and Sides, and also claims 8, 14, and 20 for being obvious over APA in view of Verthein, Sides, and Liu.

Appeal 2007-2433  
Application 09/924,029

DECISION

The Examiner's rejection of claims 1 to 20 is Reversed.

REVERSED

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